

Application No. 10/084,895

Reply to the Office Action of April 19, 2004

**REMARKS**

Applicants have amended claims 1, 11, 16, 22, 23, 32 and 33 to clarify ambiguities and further clarify unique aspects of the present invention, and claim 20 has been amended to present the claim in independent form with all of the limitations of the originally presented claim. Applicants have cancelled the double claim 5 without prejudice in response to Examiner correctly pointing out that Applicant's erroneously presented two claims numbered "5". No new matter has been added. Claims 1-32 are now pending in this application.

In the Office Action dated April 23, 2004, the Examiner allowed claims 12, 13, 26-31. The Applicants appreciate the Examiner's efforts in examining claims 12, 13, 26-31 and continue to present claims 12, 13, 26-31 in the original allowable condition. The Examiner also rejected claims 1-11, 22-25, 32 and 33 under 35 U.S.C. 112 as being indefinite, claims 1, 4, 5, 9, 11, 14, and 15 under 35 U.S.C. 102(b) as being anticipated by Stoy et al. (U.S. Patent No. 4,173,606) and claims 16-19 under 35 U.S.C. 103(a) as being obvious over Stoy et al..

The undersigned has reviewed the April 23, 2004, Office Action and respectfully traverses all rejections for the reasons set forth herein. The undersigned respectfully requests that all pending claims, as amended, be allowed.

**A. Overview**

Before addressing the merits of the rejection, some brief comments reviewing the invention may be helpful. The following comments are provided exclusively to facilitate the Examiner's review of the invention.

The present invention relates to a transfer tip and systems and processes for using the transfer tip. (Published Application 20030031548(A1), para. 3, lines 1-3, para 10, lines 1-3.) In some specific embodiments, the transfer tip is useful for handling ophthalmic lens molds. In particular, the present invention is useful in handling a mold for ophthalmic lenses that has been created by injection molding. Typically, handling of a mold involves picking the mold up and transferring the mold from a first location to another location. Obviously in a production environment, the more efficiently such handling can occur, the better. Unique aspects of the claimed transfer tip allows for a mold to be handled with less applied vacuum and evacuation volume, which, in turn, increases efficiency.

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**B. Examiner's Objections**

The Examiner has objected to claim 20 as being dependent upon a rejected base claim. Applicants have amended claims 20 to present it in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully suggest that claim 20 has now met the Examiner's conditions for allowance and request that claim 20 be allowed.

**C. Examiner's Rejection Under 35 U.S.C. 112**

The Examiner has rejected claims 1-11, 22-25, 32 and 33 under 35 U.S.C. 112 as being indefinite. Applicants have amended claims 1, 22, 32 and 33 to address various instances of the use of terms lacking antecedent basis, and claim 23 to address that claim depending from itself. Claim "5 double" has been cancelled, with out prejudice. Applicants respectfully submit that all of the Examiner's rejections under 35 U.S.C. 112 have thereby been addressed.

**D. Examiner's Rejection Under 35 U.S.C. 102(b)**

The Examiner has rejected claims 1, 4, 5, 9, 11, 14 and 15 under 35 U.S.C. 102(b) as being anticipated by Stoy et al. (U.S. Patent No. 4,173,606). Applicants respectfully traverse these rejections for the reasons below, and request allowance of the claims as amended.

Stoy is directed to a method of manufacturing shaped articles from crystalline or quasi-crystalline acrylonitrile polymers. (Abstract; lines 1-3.) Descriptions of various examples of how Stoy can be implemented include casting solutions in open molds (col. 4 lines 60-67), coating ship hulls under water (col. 5 lines 34-36) and making filamentary articles such as fibers (col. 5 lines 54-61). The Examiner has focused on a particular mention of a two-piece mold described in Stoy with an inlet 17 and an outlet 18 (col. 10 lines 40-50 and Fig. 4). Stoy does not suggest or describe any apparatus that may be useful in handling any part of the mold described in Stoy and illustrated in Fig. 4.

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As the Federal Circuit instructs "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Furthermore, the prior art reference must disclose each element of the claimed invention "arranged as in the claim." Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452 (Fed. Cir. 1984). Thus, in order for the present rejection under 35 U.S.C. 102(b) to be proper, the Stoy reference "must clearly and unequivocally disclose the claimed [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." In re Arkley, 455 F.2d 586, 588 (C.C.P.A. 1972).

In stating his rejections of independent claims 1 and 14, the Examiner erroneously equated a "tip" with a mold. Applicants claim a "transfer tip" for handling a mold, not the mold itself. Stoy describes a mold, but does not describe, or suggest a transfer tip. Both independent claim 1 and independent claim 14, contain elements that include a transfer tip that has "an outer surface ... complementary to ... the lens mold." These elements thereby clearly differentiate the transfer tip from the mold. The mold is further differentiated from the mold by the sealing means for engagement of the lens mold. Applicants have claimed a transfer tip for handling a mold portion, not the mold portion itself.

Unique aspects of the claimed handling tip include the rigid body portion that is complementary to the shape of the mold. According to the specification of the present invention, "complementary" includes "to be as close to form-fitting to surface (the area of non-optically relevant curvature of the lens mold) as practicable without impinging on the same" (para. 24). The art the Examiner cites does not include any reference to a transfer tip and certainly not to a transfer tip with a rigid portion that is complementary to the mold that it will handle.

Specifically, in the Office Action dated April 23, 2004, the Examiner contends on page 3 that Stoy discloses a tip. However Stoy does not disclose a tip, Stoy only discloses a mold. The Examiner further contends that Stoy discloses the tip having an outer surface that is complementary to the shape of the lens mold half to be transferred. First the Examiner falls short of a 102(b) reference because Stoy does not describe, mention or even suggest anything about transferring a mold.

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Secondly, Stoy does not describe, mention or suggest to use a complementary (as close to form-fitting to the surface as practicable without impinging on the same) transfer tip to consummate ea transfer of a mold.

Claims 4, 5, 9 and 11 depend from independent claim 1, and claim 15 depends from independent claim 14 and define further features and structure of the present invention. As such, these claims are patentable for the reasons noted above with respect to claims 1 and 14, as well as for the additional features recited therein. Accordingly, notice to the effect that claims 1, 4, 5, 9, 11, 14 and 15 are in condition for allowance is respectfully requested.

**E. Examiner's Rejection Under 35 U.S.C. 103(a)**

The Examiner has rejected claims 16-19 and 21 under 35 U.S.C. 103(a) as being unpatentable over Stoy et al. (U.S. Patent No. 4,173,606). Applicants respectfully traverse these rejections for the reasons above and for the additional reasons below, and request allowance of the claims as amended.

As discussed above, Stoy is directed to a method of manufacturing shaped articles from crystalline or quasi-crystalline acrylonitrile polymers and includes a cursory description of a mold. Stoy does not describe or suggest a system utilizing a unique type of transfer tip.

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 433, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, in order for the Examiner to establish a case of obviousness, he must (a) demonstrate that the prior art references describe or suggest all of the claimed limitations of the present invention, and (b) show a motivation to modify or combine the references. The Examiner has done none of the above

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The Examiner has not shown any suggestion or motivation to modify a method of manufacturing shaped articles from crystalline or quasi-crystalline acrylonitrile polymers into a specifically described transfer tip. Secondly there is no support that such a method of manufacturing shaped articles from crystalline or quasi-crystalline acrylonitrile polymers would be successfully modified to create the claimed unique transfer tip. Thirdly, the cited art does not teach or suggest all the claim limitations.

Stoy makes no mention of a robotic assembly and does not describe or suggest in any manner a transfer tip for picking up a lens mold half from one location and depositing it at a second location. Further, with no transfer tip mentioned or suggested in Stoy, it cannot possibly describe or suggest a transfer tip with the specific unique limitations claimed in the present invention, such as for example, a transfer tip with a substantially rigid body and an outer surface that is complementary (close to form-fitting to surface (the area of non-optically relevant curvature of the lens mold) as practicable without impinging on the same) to the shape of the lens mold half to be handled and at least one aperture extending through the body portion.

Applicant's therefore respectfully submit that a case for obviousness has not been established because (a) the prior art does not describe or suggest all of the claimed limitation of the present invention and (b) no motivation to modify or combine Stoy with anything has been demonstrated.

### CONCLUSION

Allowance of this application, as amended, is courteously urged.

Respectfully submitted,

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/ Joseph P. Kincart /

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